

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: XIADONG LI ET AL.

Serial No.: 10/319,821

Group Art Unit:

Filed: DECEMBER 16, 2002

Examiner:

Title: CHIMERIC GATIPHAL 15 VARIANTS AND THEIR USE IN THE  
ANALYSIS AND DISCOVERY OF MODULATORS OF G-  
PROTEIN COUPLED RECEPTORS

**PETITION TO REVIVE PURSUANT TO 37 C.F.R. §1.137(a) OR (b) AND  
RULE 53 ON THE BASIS THAT THE APPLICATION SHOULD HAVE BEEN  
AWARDED A FILING DATE BECAUSE THE FIGURES WERE ACTUALLY  
OR CONSTRUCTIVELY INCLUDED OR ALTERNATIVELY ARE NOT  
NECESSARY FOR AN UNDERSTANDING OF THE INVENTION AND  
BECAUSE APPLICANTS' FAILURE TO TIMELY RESPOND TO THE  
ERRONEOUS NOTICE OF INCOMPLETE APPLICATION WAS  
UNAVOIDABLE OR UNINTENTIONAL**

**Mail Stop**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for revival of the above-identified utility patent application based on the unavoidable or unintentional failure of Applicants to timely respond to the Notice of Incomplete Application mailed on February 27, 2003, setting a non-extendable deadline of April 27, 2003 for response.

As detailed herein, and as supported by an affidavit by the undersigned, the failure of Applicants to timely respond was unavoidable or unintentional because Applicants did not receive the Notice of Missing Parts in their office until May 7, 2003 which is after this deadline had lapsed.

Also, Applicants submit evidence herein that they should have been accorded a filing date on filing this application of December 16, 2003, based on the papers submitted on said date, because these filing papers included Figures 1 and 2. That these figures were submitted with the application papers submitted with the Patent Office on December 16, 2002, is constructively established by a stamped postcard returned from the Patent Office which makes reference to these figures (attached as an Exhibit A to a Declaration by the undersigned). It is based on this alleged deficiency that Applicants' application was not accorded a filing date<sup>1</sup>. However, based on the stamped postcard attached was Exhibit A, those figures were included in the as-filed documents.

Further Applicant respectfully note that the application filed on December 13, 2002, claims priority to US Provisional 60/339,466, filed December 14, 2001, and that this application is incorporated by reference in its entirety. This application contains the same allegedly omitted Figure 1 and 2 (Exhibit B). Accordingly, Applicants respectfully note that an amendment could be introduced requesting

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<sup>1</sup> While the Application was filed without a filing fee, executed declaration, and sequence listing, the reason for the failure to accord a filing date was only based on the alleged figure deficiency.

entry of these figures (which are part of provisional application 60/339,466) as they constitute information which was incorporated by reference into this application (assuming arguendo that the Patent Office does not accept the copy of the PTO stamped postcard as evidence that these figures were filed with the subject application).

Additionally, Applicants respectfully submit that even if these figures had not been submitted on filing this Application, a filing date still should be accorded, as these figures are not necessary for an understanding of the invention. Rather, these figures merely contain experimental results and are not necessary for descriptive support of any of the claims.

Therefore, as set forth in detail herein, and as supported by the Declarations and exhibits thereto submitted herewith, Applicants petition for revival of this Application on the basis that:

- (i) the Application was filed with the allegedly omitted Figures and therefore should have been accorded a filing date;

- (ii) even assuming that the figures were not filed, the present Application still should have been accorded a filing date as these figures are not necessary for an understanding of the invention;

- (iii) even assuming that the Patent Office does not accept the postcard evidence substantiating that the figures were filed with the application papers, an amendment could be introduced directing entry of these figures, based on the fact that this application incorporated by reference in its entirety the

contents of U.S. Serial No. 60/339,466 filed on December 14, 2001, which application includes these same figures; and

(iv) Applicants' failure to timely respond to the Notice of Incomplete Application mailed on February 27, 2003 was unavoidable or unintentional because Applicants did not receive this notice in their offices until the due date of responding to this paper (April 27, 2003) had lapsed. The facts supporting these underlying allegations are set forth in detail below and are further supported by the Affidavit by the undersigned and exhibits thereto.

1. **Applicants' Application filed December 16, 2003 Should Have Been Accorded a Filing Date as The Figures Were Included**

Applicants' petition for revival of the Application filed on December 16, 2002 is in part on the basis that the figures were included with the application papers submitted to the Patent Office on this date. This fact is evidenced by the stamped postcard received from the Patent Office which includes reference to two figures. As indicated in my supporting Affidavit, it is my practice to compare the items listed on the postcard to the items submitted to the Patent Office. Therefore, it is my belief that these figures were included or they would not have been mentioned on the postcard (Exhibit A).

Alternatively, Applicants petition for a filing date based on the fact that the figures are not necessary for an understanding of the invention. More particularly, they are not necessary to provide written description support, to enable, or to satisfy the utility requirement for any invention disclosed or claimed in this Application.

The figures merely contain experimental data, which is not necessary for an understanding of the claimed invention (Exhibit B).

Still alternatively, Applicant petition for a filing date on the basis that these figures did comprise part of the as-filed application based on the fact that this application incorporates by reference the entirety of U.S. Provisional Serial No. 60/339,446, filed on December 14, 2001, which application includes these figures. Accordingly, even assuming that the Patent Office did not accept the postcard proof that these figures were included with the application as-filed, an amendment could be introduced requesting entry of these figures on the basis that they were included in the as-filed application based on the fact that this application incorporates in its entirety the contents of U.S. Provisional 60/339,446, at page 1 of the as-filed application.

Therefore, based on the foregoing, Applicants respectfully submit that a filing date should have been accorded to this application because these figures were included and/or are not necessary for an understanding of the invention.

**2. Applicants' Failure to Timely Respond to the Notice of Incomplete Application was Unavoidable or Unintentional**

Applicants further respectfully petition for revival of this Application on the basis that the failure to timely respond to the Notice of Incomplete Application was unavoidable or unintentional.

Applicants respectfully petition that this Application be revived to pending status because Applicants' failure to time respond to the Notice of Incomplete Application was unavoidable or unintentional because Applicants' attorney received this Notice after the period for responding to the Notice had lapsed.

Particularly, the Notice of Incomplete Application set a non-extendable two-month response date that lapsed on April 27, 2003. However, Applicants' attorney only received this paper in their Office on May 8, 2003. This delay was unavoidable because of the following chain of events.

(i) Specifically, on March 21, 2003, Applicants' counsel moved from Pillsbury Winthrop LLP to Crowell & Moring LLP. On that date, I had no patent files in my possession as I only notified my clients of my departure on my start date at Crowell & Moring LLP. I was not permitted to notify my clients earlier because of ethical rules which I strictly followed.

(ii) On March 21, 2003, I contacted the clients that I was working with including Senomyx, Inc. of my relocation to Crowell & Moring LLP. At that point, I inquired whether Senomyx desired to transfer their files to Crowell & Moring LLP, or retain their files at Pillsbury Winthrop LLP. Senomyx advised me that they wanted to transfer their files to Crowell & Moring LLP. A transfer letter from Senomyx was received by us on April 1, 2003.

(iii) On or about April 2, 2003, we started receiving the transferred files into our offices along with other client files. In total, approximately 1000 files were eventually transferred into Crowell & Moring LLP from Pillsbury Winthrop LLP. This file transfer process took about a month to complete.

(v) Because Crowell & Moring LLP uses a different electronic docket system than does Pillsbury Winthrop LLP (Pattsy docket system, rather than CPI docketing system used by Pillsbury Winthrop), we diligently began the process of manually docketing transferred cases into Crowell & Moring LLP's electronic docket system. Also, because of the large volume of transferred cases we gave priority to the docketing of cases with imminent due dates. As I am the responsible attorney for Senomyx matters, as well as several other transferred clients, I closely reviewed all Senomyx's transferred files and had the most imminent due dates immediately manually introduced into our electronic docket system. As evidence of this fact, I provide a copy of an electronic docket dated April 11, 2003 that includes all due dates for transferred cases spanning April 11 through April 28, 2003 (Exhibit C). On inspection of this docket record, it can be seen that there is no entry for this Application on April 27, 2003. However, there are other Senomyx cases and due dates listed to this docket report. As further evidence of this fact, I attach to my affidavit an electronic docket report printed on May 6, 2003 (Exhibit B). This docket report similarly does not contain an entry for the Notice of Incomplete Application due on April 27<sup>th</sup> for this application (Exhibit D). Likewise, an electronic docket report dated May 7, 2003 contains no docket entry for filing a

response to the Notice of Incomplete Application due April 27, 2003 (Exhibit E). However, it likewise contains many other Senomyx due dates. Rather, the first time that the Notice of Incomplete Application appeared on my docket was the electronic docket report dated May 9, 2003 (Exhibit F). This is because the Senomyx files transferred to our office on or about April 2, 2003 did not include the Notice of Incomplete Application. Thus, I was unaware of the April 27<sup>th</sup> due date until May 8, 2003, which is after this due date had lapsed.

(v) Because of the large volume of transferred cases, and the fact that mail continued to go to Pillsbury Winthrop LLP (the attorney of record) until we were able to prepare and file changes of address and Power of Attorney forms for roughly 1000 cases pending in the United States and a number of different foreign jurisdictions, we arranged for correspondence received by Pillsbury Winthrop LLP (until the changes in addresses were finalized) to be sent by Pillsbury promptly on receipt to Crowell & Moring LLP. This was deemed necessary in order to avoid any due dates being missed.

(vi) Also, I requested that my transition attorney at Pillsbury Winthrop LLP send us all fax and mail correspondence promptly so that no due dates would be missed. Further, procedures were instituted at Crowell & Moring LLP whereby the correspondence received from Pillsbury Winthrop was reviewed by me on the day of receipt (as I was the responsible attorney). I was the person who reviewed the correspondence daily, because given my familiarity with cases, I would



be best able to review files for any imminent due dates. After my review of the correspondence, I promptly and diligently had the due dates entered into Crowell & Moring LLP's electronic docket system. This is evidenced by the Crowell electronic docket reports dated April 11, 2003 (Exhibit C), May 6, 2003 (Exhibit D) and May 7, 2003 (Exhibit C), all of which contain a number of Senomyx matters but do not include a docket entry for filing a response to the Notice of Incomplete Application for this case. This is because the Notice of Incomplete Application was not received by Crowell & Moring LLP until after the due date for response had lapsed.

(vii) On May 8, 2003, Applicants first became aware of the April 27, 2003 due date. This is evidenced by the electronic docket dated May 9, 2003, which is the day after Crowell & Moring LLP received this paper from Pillsbury and I had this paper docketed it into Crowell & Moring LLP's electronic docket system. Had this paper been received earlier by Crowell & Moring LLP, because of correspondence and docketing procedures set up during my transition into Crowell & Moring LLP, this paper would have appeared on my electronic docket printed on May 7, 2003. This is evidenced by the fact that the printed docket report dated April 11, 2003 (encompassing April 11 through April 28, 2003) (Exhibit C) contains many docket entries for Senomyx cases, as does the docket report dated May 6, 2003 and May 7, 2003 (Exhibit E). These reports establish that we promptly and diligently docketed the transferred cases into the Crowell electronic docket system but that this paper was not docketed as of the due date as it was not received by us until the due date for response had passed. Also, these electronic docket reports

establish that as of May 7, 2003, Crowell & Moring LLP was not in possession or aware of the Notice of Incomplete Application mailed by the Patent Office on February 27, 2003 advising that this application was allegedly incomplete and therefore did not receive a filing date.

(viii) It was only on May 8, 2003 that Applicants' attorney became aware of this paper and docketed the April 27, 2003 due date (which by that point had passed). This fact is evidenced by a copy of an electronic docket reviewed by me that was printed on May 9, 2003 which is Exhibit D to my affidavit. Based on correspondence and docketing procedures in place during my transition, I can attest to the fact that this is the day after this paper was first received in our offices. I review and have docketed all correspondence received from Pillsbury Winthrop LLP daily for cases that I am the responsible attorney. Had this paper been earlier received, more particularly, received as of May 7, 2003, it would have appeared on my docket at least as of this date.

(ix) Also, the failure to timely respond to this paper could not have been avoided by filing a change of address. As noted above, we only started receiving Senomyx files at Crowell & Moring LLP on April 2, 2003. This is after the date that the Notice of Incomplete Application had been mailed. Moreover, as we did file the application with the figures (as substantiated by the stamped PTO postcard), I had no reason to believe that a Notice of Incomplete Application with a non-extendable two-month date for response would have been issued. Rather, upon

review of the transferred file, I simply thought that a Notice of Missing Parts would soon be received, giving us the normal two-month response date, with extensions (up to five months) available under §1.136(a).

(x) Therefore, based on these facts and supporting evidence (my affidavit and exhibits attached hereto), Applicants' failure to respond to the Notice of Incomplete Application was unavoidable, or alternatively was unintentional.

3. **Upon Discovery of the Notice Incomplete Application, Applicants Diligently Attempted to Procure All Items Necessary to Complete the Application and Respond to the Notice**

(i) Promptly on discovery of the Notice of Incomplete Application and the missed due date, I called the Application Branch and researched what evidence was needed to revive the Application.

(ii) Particularly, I noted that the following items were required for completion:

- (a) drawings (allegedly not filed)
- (b) statutory fee of \$375
- (c) oath or declaration by inventor
- (d) computer readable form of sequence listing

(iii) I immediately noted that our copy of the filed application included the figures, and that the figures were noted on the postcard filed with and stamped by the Patent Office. Therefore, had I timely received the Notice, proof was available substantiating that the figures were filed, and readily could have been provided to the Patent Office. Alternatively, I noted that the figures are not

necessary for an understanding of the invention and could be deleted if necessary to procure the original filing date (if the Patent Office did not accept the postcard evidence). Still further, I noted that I had incorporated by reference a provisional application, which contains the same allegedly omitted figures.

(iv) At that point, I diligently sent a copy of the Application to the service we use to prepare sequence listings.

(v) After that review, I thereupon prepared a copy of Inventors' Declaration for signature by all of the inventors. On June 19, 2003, I received the signed Declaration and Assignment signed by all but one inventor. Unfortunately, I ran into an obstacle with a non-signing inventor, (Jon Elliot Adler). As evidenced by a Petition Under 37 C.F.R. §1.47(a) filed concurrent with this Petition, Dr. Adler's attorney was sent a copy of this Application and Oath, but has refused to sign this paper.

As established by the Petition under §1.47(a), Dr. Adler terminated his employment with Senomyx on May of 2002. Dr. Adler was provided a copy of the as-filed application, including figures, specification and claims, and the accompanying declaration and assignment via his attorney, Ms. Marilynn Mika Spencer. (See accompanying §1.147(a) Petition and Declaration in support thereof.) Specifically, we requested that Dr. Adler or his attorney return to us the signed documents no later than July 20, 2003, for filing in the Patent Office. To date, the

signed documents have not been received in our office. Therefore Applicants are unable to provide an executed declaration by Dr. Adler.

Based thereon, this Petition and the accompanying Response to the Notice of Incomplete Application is submitted with all necessary items except an executed declaration by Jon Elliot Adler. In lieu thereof, a Petition Under §1.47(a) is filed herewith along with a declaration and exhibits in support thereof.

4. **A Complete Response to the Notice of Incomplete Application is Submitted Herewith**

Submitted with this Petition is the response to the Notice of Incomplete Application, and all items necessary to complete the Application, and the Petition Fee of \$130.00. Also, the allegedly omitted figures are enclosed. As the failure to respond to the Notice of Incomplete Application is believed to be unavoidable, no other fees are believed to be required.

However, should any other fees be necessary to place this Application in good standing, the Patent Office is expressly authorized to charge Applicants' deposit account any additional fees.

Accordingly, based on the foregoing, Applicants respectfully petition for revival of this Application to pending status on the basis that the failure to timely respond to the Notice of Incomplete Application was unavoidable or unintentional. Applicant respectfully submit that they have provided sufficient evidence to

establish that the Application was filed with the figures, and that based thereon a filing date should have been accorded, and even if the figures had not been submitted, they were part of information incorporated by reference in the as-filed application, and further, even if the Patent Office does not accept this postcard evidence or the fact that an application containing these same figures were incorporated by reference in the as-filed application, a filing date should still be accorded as the figures are not necessary for an understanding the invention.

Also, Applicants respectfully submit that they have provided convincing evidence that the failure to timely respond to the Notice of Incomplete Application was unavoidable or unintentional and that this application should therefore be revived because Applicants did not receive this paper in their office until after the due date had passed, and thereupon diligently obtained the items necessary to complete this application.

It is believed that Applicants have provided all the necessary information for the Patent Office to grant their Petition. However, if any other information is required, the Patent Office is respectfully requested to contact the undersigned.

Respectfully submitted,

August 5, 2003



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